

## **REMARKS**

The applicant provides the following remarks to the non-final action mailed April 7, 2010.

1. **Status Of The Claims.** Claims 1-3, 8, 31, 39-52 and 62-72 are pending in the subject application. Claims 1-3, 8, 31 and 40 are rejected under 35 U.S.C.A. Section 112, first paragraph, as containing new matter. Claims 1-3, 8, 31, 40 and 65-72 are rejected under 35 U.S.C.A. Section 112, second paragraph, as being indefinite. Claims 1-3, 8, 33 and 65-69 are rejected under 35 U.S.C.A. Section 102 (b) as being anticipated by Rath et al., J Anim Sci 77: 3346-3352, 1999 ("Rath").

Claims 4-7, 9-30, 32-38 and 53-61 are without prejudice cancelled. Claims 41-52 and 62-64 are withdrawn for consideration as nonelected subject matter. Claims 2, 31, 39, 40, 66-72 have been previously presented. Claims 3 and 8 are as originally presented. Claims 1 and 65 are currently amended.

Applicant respectfully reserves the right to pursue any non-elected claims, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

2. **The Rejections Under 35 U.S.C.A. Section 112, First Paragraph Are Overcome.** In the present application, the Examiner has rejected claims 1-3, 8, 31, 39, and 40 as failing to comply with the written description requirement. *Office Action at Page 3*. Claim 1 recites "altering flow characteristics of said fluid stream pressure to 30 psi and 40 psi". *Id.* Claims 2, 3, 8, 31, and 40 depend ultimately upon claim 1. Applicant has amended claim 1 to include the language --altering said flow characteristics of said fluid stream to adjust fluid stream pressure to between about 30 psi and about 40 psi-- to make clear that Applicant is not claiming "using at least two different fluid stream pressures for sorting a sperm cell sample". The amendment to claim 1 is supported by the specification at Paragraphs 0035 and 0038. See also, original Claim 15.

The Examiner also indicates that the same rejection has been applied to claim 65. *Office Action at Page 5.* However, Applicant does not see that claim 65 includes the language “altering flow characteristics of said fluid stream pressure to 30 psi and 40 psi”. Applicant believes that the Examiner has inadvertently applied the same rejection to claim 65.

Based on the amendment to claim 1 and because claim 65 does not include the same language which was the basis of the rejection of claim 1 and because claims 2, 3, 8, 31, and 40 depend upon claim 1, Applicant respectfully requests that the Examiner withdraw the Section 112, First Paragraph, rejection as to claims 1-3, 8, 31, 39, and 40.

3. **The Rejections Under 35 U.S.C.A. Section 112, Second Paragraph Are Overcome.** The Examiner further rejects claims 1-3, 8, 31, 39, 40 and 65-72 under Section 112, Second Paragraph, as being indefinite with respect to the terms “viability” and “cleavage rate” because it is unclear what “viability” and “cleavage rate” are referring to.

Applicant has addressed this concern by amended claim 1 to make clear what “viability” and “cleavage rate” are referring to, as follows:

“altering said flow characteristics of said fluid stream to adjust fluid stream pressure to between about 30 psi and about 40 psi, said fluid stream pressure based on said at least one desired sperm cell fertility characteristic, wherein said fluid stream pressure is adjusted to a pressure selected from a group consisting of about 30 psi when sperm cell motility is selected, about 40 psi when sperm cell motility is selected, about 30 psi when sperm cell viability is selected, about 40 psi when viability is selected, about 40 psi when oocyte cleavage rate is selected; about 40 psi when oocyte blastocyst rate is selected, and about 30 psi when pregnancy rate is selected;”

The amendment is supported by the specification at Paragraph 0049 which indicates that:

“Cleavage (53.6 and 43.6%) and blastocyst (18.2 and 14.7%) rates were higher for procedures utilizing sperm cells having controlled sperm cell characteristics obtained at about 40 psi than at about 50 psi ( $P < 0.01$ ).”

The amendment reciting --about 30 psi when sperm cell viability is selected, about 40 psi when viability is selected-- is supported by the specification at Paragraphs 0004, 0008, 0012, and one of ordinary skill in the art would understand that sperm cell viability as claimed refers to the percentage of dead sperm cells. See attached Exhibit A, second page “a stain is used to identify the percentage of dead sperm. This is called the sperm viability test.”

Applicant having amended claims 1 and 65 to make clear what “viability” and “cleavage rate” are referring to and providing support for the amendment from the specification and what a person of ordinary skill in the art would understand of the term “viability”, respectfully requests that the Examiner withdraw the Section 112, Second Paragraph rejection as to claims 1 and 65 and the claims 2-3, 8, 31, 39, 40 and 66-72 made ultimately dependent upon thereon.

4. **The Rejections Under 35 U.S.C.A. Section 102 Are Overcome.** In the present application, the Examiner rejected claims 1-3, 8, 33 and 65-69 as being anticipated by Rath et al., J Anim Sci 77: 3346-3352, 1999 (“Rath”).

In the office action mailed 8/8/2008, this rejection was withdrawn because the claims encompassed the limitation of “adjust the fluid stream between at least two different fluid stream pressures”. *Office Action at Page 7.* The Examiner has construed the claim amendment filed February 6, 2009 as reading “30 psi or 40 psi” which was not intended by the Applicant. Applicant believes that the claims as amended overcome the Rath reference by reciting “adjust fluid stream pressure to between about 30 psi and about 40 psi,”.

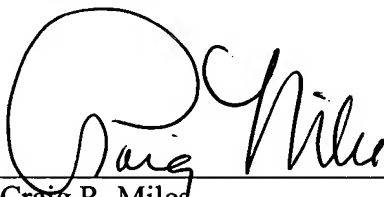
5. **Continuing Application.** Applicant has filed a continuing application claiming priority to this application and those applications to which this application claims the priority and benefit of.

## CONCLUSION

Claims 4-7, 9-30, 32-38 and 53-61 are without prejudice cancelled. Claims 41-52 and 62-64 are withdrawn for consideration as non-elected subject matter. Claims 2, 31, 39, 40, 66-72 have been previously presented. Claims 3 and 8 are as originally presented. Claims 1 and 65 are currently amended. The amendment to claims 1 and 65 along with the remarks made by Applicant are believe to place claims 1-3, 8, 31, 39, 40, 65, and 66-72 in condition for allowance and Applicant respectfully requests allowance of claims 1-3, 8, 31, 39, 40, 65, and 66-72.

Dated this 23 day of August, 2010

Respectfully Submitted,

By:   
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